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ATTORNEY DOCKET NO. ISM/005

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

ADNAN SHENNIB

Serial No.: 09/199,669

Filed: 11/25/1998

Title: SEMI-PERMANENT CANAL HEARING DEVICE

Confirmation No. 3957

Group Art Unit: 2643

Examiner: Dionne Harvey

LETTER

Commissioner of Patents and Trademarks
Washington, DC 20231

Responsive to the restriction requirement imposed in the Office Action of 01/29/2003, applicant provisionally elects claims 1-49, 98-124 and 125-137, asserted to be drawn to examiner's designation of Invention I, with traverse.

Applicant respectfully traverses the restriction requirement with respect to the inventions that are designated in the Action as I and II, and urges examiner to reconsider her position that the claims in those categories are drawn to distinct inventions. Applicant submits that the inventions designated I and II have not been shown by examiner to be both independent and distinct as required by 35 U.S.C. 121 to support a restriction requirement, nor to meet the criteria imposed by the MPEP for such a finding. It is further submitted that the reasons given for the examiner's conclusion are inadequate under the MPEP.

In particular, the MPEP imposes the following criteria, guidelines and requirements to support a proper requirement of restriction to one of two or more claimed inventions under the statute. Namely, the restriction requirement can be made only if (1) the claims are able to support separate patents and they are either (i) independent or (ii) distinct; and (2) a serious burden is imposed on the examiner to examine the entire application on the merits, even though it includes claims to independent or distinct inventions.

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The MPEP guidelines include a requirement that the examiner must provide reasons and/or examples to support her conclusions. Despite a *prima facie* showing of a serious burden by appropriate explanation, by showing a separate classification or status in the art, or a different field of search, it may be rebutted by appropriate evidence by the applicant.

Further, the MPEP states for a finding that inventions drawn to a combination and a subcombination are distinct, it must be shown that (a) the claimed combination doesn't require the particulars of the claimed subcombination for patentability (to show novelty and unobviousness), and (b) the subcombination has utility either by itself or in other and different relations. When these factors cannot be shown, the inventions are not distinct.

Referring to the claims in question:

Claims 1-49 are drawn, in brief, to:

a semi-permanent hearing device comprising:

a sealing retainer for seating in the ear canal's bony portion along longitudinal axis, in direct contact with the walls, w/device fully inserted in the ear canal;

a receiver assembly including a receiver for supplying acoustic signals to the tympanic membrane, and adapted to mate with said retainer for positioning in the bony portion of the ear canal;

a microphone assembly including a microphone to receive incoming acoustic signals for processing by said device;

a battery assembly including a battery for powering said device; and

a flexible connector electrically and mechanically connecting battery assembly, receiver assembly, microphone assembly, to flexibly support microphone assembly in the cartilaginous portion of the ear canal for substantial non-occlusion and minimal contact with the walls thereof, to avoid interference by microphone assembly with hair and production of cerumen and debris.

Claims 50-97 are drawn, in brief, to:

a semi-permanent hearing device comprising:

a sealing retainer for seating in the ear canal's bony portion along longitudinal axis, in direct contact with the walls, w/device fully inserted in the ear canal;

a receiver assembly including a receiver for supplying acoustic signals to the tympanic membrane, and mating with said retainer for positioning said receiver in the bony portion of the ear canal;

a microphone assembly including a microphone to receive incoming acoustic signals for processing by said device;

a battery assembly including battery for powering said device, an enclosure, a connector electrically connecting battery, receiver, microphone; the battery assembly having a shape substantially equivalent to the battery, the microphone assembly positioned in the ear canal's cartilaginous portion for minimal contact with the walls and substantial non-occlusion, for minimal interference with hair and production of cerumen and debris within said ear canal.

With due respect, it should be abundantly clear that the claims of both Inventions I and II are drawn to a semi-permanent hearing device; and that claims 50-97 (designated by examiner as Invention II) are not drawn to a battery assembly of a hearing device, any more than claims 1-49 (designated by examiner as Invention I) are drawn to a battery assembly of a hearing device; and that Inventions I and II (as so designated) are not related as combination and subcombination, but rather as substantially the same combination of elements. Inventions I and II are neither independent nor distinct.

Furthermore, claim 2, which depends on claim 1, recites that the "battery assembly includes a thin enclosure substantially conforming to the shape of said battery," similar to the recitation regarding the battery assembly in claim 50. Accordingly, it is submitted that it would be impermissible for examiner not to examine the entire application with respect to claims 1-49 and claims 50-97, much less to argue that a combination and subcombination are involved, that they have acquired separate status in the art, and that it would impose a serious burden on the examiner to examine the entire application on the merits.

In view of the above remarks, it is submitted that the restriction requirement is erroneous as applied to the claims drawn to the examiner-designated inventions I and II, and should be withdrawn. Applicant does not dispute the restriction requirement pertaining to claims 138-140, and those claims are non-elected herein, without traverse.

Respectfully submitted,

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